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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,571	07/21/2003	Masaru Iriya	0071-0528P	4799

2292 7590 07/12/2005

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PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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RAYFORD, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/622,571

Applicant(s)

IRIYA ET AL.

Examiner

Sandra M. Nolan-Rayford

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: (See the attachment.). (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-13.

Claim(s) withdrawn from consideration: None.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: the rejections set out in the 3-1-05 Office Action are still deemed proper.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_

*S.M. Nolan-Rayford*

SANDRA NOLAN RAYFORD

PRIMARY EXAMINER

7-7-05

**ATTACHMENT TO ADVISORY ACTION**

***Claims***

1. Claims 1-13 are pending.

***Proposed Amendment Not Entered***

2. The response dated 27 June 2005 contained a proposed amendment to claim 1. That amendment has not been entered.

The term "exposed" introduces both a new issue and new matter into the claims.

**A. New Issue**

The claims did not earlier recite the limitation that at least one layer be exposed. Therefore, introducing that feature into the claims would raise a new issue.

**B. New Matter**

The original disclosure does not contain support for the term "exposed". The examiner has not been able to find the term in the specification as filed.

***Response to Arguments***

3. Applicant's arguments filed on pages 5-13 of the 27 June 2005 have been fully considered but they are not persuasive.

The examiner will respond in summary fashion. This is an advisory action, not an Examiner's Answer.

The examiner notes applicants' comment regarding her remarks in the interview summary. No further comment will be made here.

The examiner notes applicants' comments that the objection to claims 2 and 6-7 is considered a matter of style and that applicants prefer the present wording.

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However, the objection, as originally presented, is maintained.

The examiner notes that applicants have combined the rejections set out in paragraphs 10 and 14 and stated that the Japanese citation is "optionally" included.

The examiner disagrees with this summary of the two rejections. Claims 6-7 were rejected over one combination of references and claims 1-13 were rejected over another combination of references. The term "optionally" is not in either rejection.

On page 8, applicants argue that Kuroki could not have an exposed surface layer formed from a polyester having certain properties.

However, the amendment that would have added the term "exposed" to applicants' claims is unentered, so that limitation is not recited in the claims.

On pages 9-13, applicants argue that the rejection of claims 1, 3-5 and 8-13, as stated in paragraph 13 of the last office action, is improper. Some of those comments are addressed here.

On page 10, they argue that the films of Topolkaraev and Shibata have different roughness values.

However, that argument does not render the combination of the references improper because the combination rejection is based upon the use of films having the roughness of Shibata's films and the chemical constitution of Topolkaraev's films. In other word, Shibata was applied *because* its roughness differed from Topolkaraev's.

On pages 10-12, applicants argue that Topolkaraev's film is far rougher than applicants'.

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However, that argument is not persuasive because Shibata's films are similar in roughness to applicants and the rejection is based upon the combined teachings of Topolkaraev and Shibata—and not either separately.

On page 12, applicants argue that the motivation "prong" of the obviousness analysis is missing from the 35 USC 103 rejection.


However, the examiner maintains that the necessary analysis/support for this rejection has already been provided in the record.

***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

  
S. M. Nolan-Rayford 7-7-05  
Primary Examiner  
Technology Center 1700

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